

Appl. No. 10/820,850
Amdt. Dated 07/07/05
Reply to Office Action of 04/07/05

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application.

Original Claims are Patentable

Regarding the examiner's rejection of claims 1-13 under 35 U.S.C. § 103(a), Applicant respectfully submits the combined teachings of Schmitz, Fleshman Jr. and Conrad teach away from the simplicity of the present invention, which provides a solution to the problem of labeling a wire and a corresponding receptacle on an electronic device with a minimum of manufacturing steps. See *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) (prior art reference "appears to teach away from the selection of" the claimed composition "by focusing on more complex examples"). The fact that a simple solution has escaped other workers in the art is some evidence that it was **not obvious** to a person of ordinary skill in the art. See *In re Shelby*, 311 F.2d 807, 810, 136 USPQ 220 (CCPA 1963):

Schmitz does not disclose a "prong section formed from non-conductive material" nor a "male plug formed from non-conductive material", as recited in Applicant's claims 4 and 5. The examiner has taken "Official notice" that the "prong section can be formed from non-conductive material..." (see page of the examiner's Office Action). Applicant respectfully submits the examiner has excessive and improper hindsight reconstruction to build Applicant's claimed invention. Schmitz teaches away from Applicant's claimed invention because it inherently and necessarily requires "conductive" prong sections to transmit electricity through its "conductors" and operate the electronic device (see Schmitz column 3, lines 35-45). Also, it is not possible to place surface indicia on "said rear end of said body", as claimed by the Applicant, because Schmitz's rear end of its body is integrally connected to a conducting cable (see FIG. 1 of Schmitz, emphasis) and, therefore, would not be visible to receive or identify any surface indicia thereon. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

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Schmitz further teaches a "card" for indicating the relative position of a conductor to be connected to an appliance. Fleshman Jr. teaches an electrical plug connector for securely connecting two separate conducting cables together. Fleshman Jr. simply provides no teaching, suggestion nor motivation to provide a "female plug formed from non-conductive material" as claimed by Applicant. Nor does Fleshman Jr. teach the desire to use a female plug for identifying conducting cables with associated receptacles on electronic devices, as claimed by the Applicant. Therefore, a person of ordinary skill in the art would not combine Fleshman Jr.'s teaching with Schmitz to build Applicant's claimed invention.

Although Conrad teaches a means for coupling a plurality of pins to an associated receptacle by using surface indicia, neither Schmitz nor Fleshman Jr. have a desire for such surface indicia because neither prior art references provides any teaching, suggestion or motivation for employing surface indicia to match conductors with receptacles. Therefore, although Conrad teaches such surface indicia, a person of ordinary skill in the art would not find it obvious nor desirable to combine Conrad's teachings with Schmitz's and Fleshman Jr.'s teachings respectively. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue.

Amended Claims are Patentable

Should the examiner find Applicant's arguments unpersuasive, Applicant has amended independent claims 8 and 14 to more narrowly claim the present invention. Applicant respectfully submits no new subject matter has been introduced into the amended claims because all new claim recitations are clearly disclosed in the originally filed drawings and written description and, therefore, enable a person of ordinary skill in

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the art to make and use the currently amended claim recitations.


In view of these considerations, it is respectfully submitted that the rejection of the original claims and/or the currently amended claims should be considered as no longer tenable with respect to the above mentioned arguments and/or currently amended independent claims 8 and 14 respectively. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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By


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